

REMARKS

Claims 1-30 were pending. Claims 1, 10, 11, 20, 21, and 30 have been amended. Claims 16 and 26 have been cancelled.

I. Rejections under 35 U.S.C. § 102

Independent claims 1, 11, and 21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,226,287 to Brady ("Brady"). As the PTO provides in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim...." Therefore, the Brady patent must disclose all of the elements of the claims to sustain the rejections. Accordingly, Applicant respectfully traverses these rejections on the following grounds.

A. Independent claim 1

Independent claim 1 has been amended and is deemed allowable.

B. Independent claims 11 and 21

Independent claim 11 has been amended to incorporate the substance of claim 16, which stands rejected under § 103 over Brady in view of U.S. Patent No. 5,999,965 to Kelly ("Kelly"). Independent claim 21 has been amended to incorporate the substance of claim 26, which stands rejected under § 103 over Brady in view of Kelly. As such, the following remarks are directed to the Examiner's rejection of claims 16 and 26 under § 103. As the Examiner has rejected claims 16 and 26 together, the following remarks also treat these claims together.

1. Combination fails to teach or suggest all claim limitations

As the PTO recognizes in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added). Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness."

As admitted in the Office Action, Brady fails to disclose tracking how much time the user has been on hold and prioritizing the user within a queue when the user calls back, and so the Examiner relies on Kelly. (Office action ("OA"), p. 14). However, Applicant submits that Kelly fails to supply the deficiencies of Brady.

More specifically, the Examiner states that Kelly teaches "a) an abandoned call tracking feature for recording the amount of time a user has waited before abandoning the call, and transferring the information to an agent for callback, (col. 20, lines 53-57); b) a call prioritizing feature that prioritizes users within a queue depending on how much time a user has been on hold, (col. 21, lines 54-67, col. 22, lines 1-2)." (OA, p. 14). The Examiner then states that "[a]lthough not expressly stated, it would have been obvious to a person, at the time of the present invention, to use the recorded abandoned call information to prioritize the user within a queue, the next time the user calls back." (OA, p. 14, last para.). According to the Examiner, "[t]his would make the link server more robust, and would facilitate a user's desired interaction with an agent." (OA, p. 15, lines 1 and 2).

Applicant submits that the Examiner's statement regarding what would have been "obvious to a person, at the time of the present invention" fails to meet the standard of MPEP § 2142, which states that "[t]he tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." (emphasis added). Applicant submits that the Examiner has produced no facts upon which to base his conclusion and has failed to produce a prima facie case. Accordingly, Applicant submits that the combination of Brady and Kelly fails to teach or suggest all the claim limitations as required by MPEP § 2143 and amended claims 11 and 21 are allowable over the cited combination of references.

2. No motivation to combine

Furthermore, even if Brady and Kelly could be combined to form a prima facie case (which they clearly cannot be, as described above), the case law is clear that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000) (emphasis added). Here, the Examiner has admitted that the recited elements of claims 1 (as amended with claim 16) and 21 (as amended with claim 25) are not expressly disclosed in Kelly and has submitted no evidence or particular findings to support his conclusion as required. Therefore, the combination of references is improper and claims 11 and 21 are allowable over the cited art.

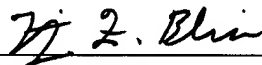
II. Rejections under 35 U.S.C. § 103

Independent claims 10, 20, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brady in view of U.S. patent publication 2003/0061354 to Burg et al. ("Burg"). Independent claims 10, 20 and 30 have been amended and are deemed allowable over the cited references. Claims 2-9, 12-15, 17-19, 22-24, and 26-29 stand rejected under various combinations of Brady, Kelly, Burg, and U.S. Patent No. 6,335,744 to Korilis et al. ("Korilis"). As claims 2-9, 12-15, 17-19, 22-24, and 26-29 depend from and further limit claim their respective independent claims, which are deemed allowable for reasons previously identified, claims 2-9, 12-15, 17-19, 22-24, and 26-29 are also deemed allowable.

Conclusion

It is respectfully submitted that all the claims in the application are in condition for allowance. Should the Examiner deem that any further amendment is needed to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

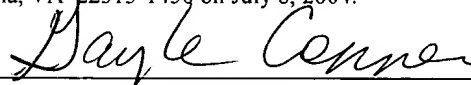
Respectfully submitted,



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